



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Detlef Stoll
Appl. No.: 09/913,451
Conf. No.: 9828
Filed: August 14, 2001
Title: CONFIGURABLE ADD-DROP MULTIPLEXING DEVICE AND OPTICAL
WAVELENGTH DIVISION MULTIPLEX TRANSMISSION SYSTEM
Art Unit: 2633
Examiner: Dalzid E. Singh
Docket No.: 112740-665

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This Response is submitted in response to the Office Action dated October 19, 2004. The Office Action issued a restriction requirement under 35 U.S.C. § 121, stating that the Application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: FIG. 5
Species II: FIG. 6
Species III: FIG. 7

Applicants respectfully traverse and submit that the restriction required in the present application is wholly improper. First, the Office Action does not demonstrate any reason for the proposed restriction as required by MPEP §803, which states that "[e]xaminers must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases . . . when plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement." It appears evident from the text of the Office Action that, aside from citing FIGs. 5-7, this requirement has not been met. The Examiner has also not provided any separate classification of distinct inventions, separate status in the art (and a separate field of search) or a different field of search as required in MPEP §803. It is well-known that if the

search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

FIGs. 5, 6 and 7 correspond to the configurable add-drop multiplexing device for an optical WDM transmission system recited in independent claims 16 and 30. The independent claims are directed in part to a species of exchangeable modules contained within the device to provide system connection and branching off of specific connections in a cost-effective way (see, e.g., substitute specification page 2, first two paragraphs). It is axiomatic that if a feature of an system includes exchangeable modules, there must be separate and/or different modules available for exchange. According to the Examiner's position however, the restriction is requiring the applicants to claim exchangeable modules without reciting any of the specific modules themselves. This is simply incorrect. Each figure corresponds to the first, second and third modules recited in the respective independent claims that contribute to providing at least some of the aforementioned advantages under a commonality of operation, function and effect (see MPEP 806.05(c)).

For at least these reasons, Applicant traverses and submits that the restriction requirement is improper and should be withdrawn. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-665) on the account statement.

Respectfully submitted,

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